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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,307	03/30/2004	David A. Dinsmoor	P-20772.00	3624
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER GILBERT, ANDREW M	
			ART UNIT	PAPER NUMBER
			3767	
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			09/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/813,307	Applicant(s) DINSMOOR ET AL.	
	Examiner Andrew M. Gilbert	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.  
4a) Of the above claim(s) 6-16, 33-40 and 48-66 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 67 and 68 is/are allowed.
- 6) ☒ Claim(s) 1-3, 17-31 and 41-47 is/are rejected.
- 7) ☒ Claim(s) 4-5, 20-23, 32, 41-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/8/2007 has been entered.

### ***Acknowledgments***

2. This office action is in response to the reply filed on 6/8/2007.
3. In the reply, the Applicant amended claims 1, 29 and added new claims 67-68.
4. Additionally, the Applicant commented that a Terminal Disclaimer had been filed (see Remarks, pg 18, paragraph 3); however, no Terminal Disclaimer was received. Thus, the rejections are maintained.
5. Claims 1-5, 17-32, 41-47, and 67-68 are pending.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 24-27, 29-31, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Kilcoyne et al (6689056).

The applied reference has a common invention with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In reference to independent claims 1 and 29, Kilcoyne et al discloses the apparatus and method comprising: a device housing (18) sized for introduction into and residence completely within the body lumen; a fixation mechanism (Figs 8-11) to attach the device housing to a surface within the body lumen; a controlled detachment mechanism (col 9, lns 55-col 10, ln 4) mechanically actuated to selectively detach the device housing from the surface of the body lumen, wherein the medical device remains completely within the body lumen until after the device is detached from the surface (Figs 8-11; col 9, lns 25-28, 43-54; col 10, lns 4-11; col 13, lns 13-16; wherein the pin is disclosed and being non-dissolvable and the collet assembly is disclosed as being usable to deploy and retract pin 164 to attached and detached the device housing; and Response to Arguments).

In reference to claim 2 and 30 (see (124); Fig 16); for claim 3 and 31 (see col 10, lns 24-26; for claim 24-25 and 45 (see col 5, ln 63-col 6, ln 4); for claim 26-27 and 46 (see col 7, ln 17-38).

8. Claims 1-3, 24-31, 45-47 rejected under 35 U.S.C. 102(e) as being anticipated by Colliou et al (7020531).

9. In reference to independent claims 1 and 29, Colliou et al discloses the apparatus and method comprising: a device housing (520) sized for introduction into and residence completely within the body lumen; a fixation mechanism (524, 564; Figs 1-13b) to attach the device housing to a surface within the body lumen; a controlled detachment mechanism (5224, 564, Figs 1-13b; col 5, lns 36-42) mechanically actuated to selectively detach the device housing from the surface of the body lumen; and wherein the medical device remains completely within the body lumen until after the device is detached from the surface (col 4, lns 53-56; col 5, lns 4-21, 36-42; 48-52; col 8, lns 9-14; Figs 10c-10e; wherein the pin is disclosed as being non-dissolvable and the pin anchoring device may be removed and replaced by the endoscopic connector tool; see also Response to Arguments).

10. In reference to claim 2 and 30 (see 522); for claim 3 and 31 (528; Summary); claim 24-25 and 45 (see Figs 1-13b, Summary); for claim 26-27 and 46 (see Figs 1-13b, Summary – ie col 7, lns 21-37); for claims 28 and 47 (see Figs 1-13b; Summary – ie col 7, lns 55-65).

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3, 17-19, 24-27, 29-31, 45-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6689056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the US Pat No 6689056. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

13. Claims 1, 17-18, 24-27, 29, 45-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17, 62-87 of copending Application No. 10/833776. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-3, 17-18, 24-27, 29-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-11, 13-16, 55-58, 61-66 of copending Application No. 10/687296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-3, 17-19, 24-27, 29-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 55-58, 66, 69, 71, 73 of copending Application No. 10/896553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application.

Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-3, 17-18, 24-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No. 10/835425. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

17. Applicant's arguments filed 6/8/2007 have been fully considered but they are not persuasive.

18. The Applicant argued that:

- i. Kilcoyne et al and Colliou fail to disclose mechanical actuation of the controlled detachment mechanism and that the detachment



mechanism does not remain completely within the body lumen until after the device is detached from the surface.

19. In response to applicant's argument (i), the Examiner notes that the metes and bounds of the Applicant's amended claim recitation of "mechanically actuated" is read upon by both the Kilcoyne et al and Colliou references. Both references utilize non-dissolvable pins that pierce tissue to retain their respective device housing completely within the body. Each pin is fully capable of being mechanically actuated to selectively detach, ie – be removed, thus releasing the device housing from the tissue, from the surface of the body lumen. During this process of attachment and detachment the medical devices of both Kilcoyne et al and Colliou remain completely within the body lumen until after the pin is removed and the medical device can be removed from the body via the stool or via a catheter tool. The Applicant's claim recitation does not limit the controlled detachment mechanism to be mechanically actuated by itself, ie the medical device. Rather, the claim scope is sufficient broad to allow for mechanical actuation via a separate catheter tool. Additionally, the Examiner notes that this same argument applies to the fixation mechanism. The Examiner suggests structurally limiting the Applicant's invention to define this point of novelty over the prior art of the record.

***Allowable Subject Matter***

20. Claims 67-68 are allowed.

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21. Claims 4-5, 20-23, 32, 41-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 2005/0060030 (see Figs 44-50 and related text); 2004/0260346 (see Fig 9 and related text).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

